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WEBMAN, E EXAMINER

15M1/0615  
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ART UNIT	PAPER NUMBER
1502	4

DATE MAILED: 06/15/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on \_\_\_\_\_  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice re Patent Drawing, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, Form PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1.  Claims 1-14 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1-14 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).

12.  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  
 been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

Art Unit: 1502

Claims 1-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 8 and 11-14 'surfaces' is vague; surfaces of what entities?

In claim 1, 8, 'synthetic polymer' is vague; which ones?

The disclosure is objected to because of the following informalities: On page 1, line 14 serial numbers are missing.

Appropriate correction is required.

On page 3, line 16; page 6, line 8; page 7, lines 8, 17 and 24; page 14, lines 1, 8; page 18, line 17; page 21, line 6 'etc' does not limit the scope of the disclosure. 'And the like' is suggested.

On page 18, line 16 dimethylacrylamide is not polymer.

Claims 1-14 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to that which is disclosed. See M.P.E.P. §§ 706.03(n) and 706.03(z).

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Applicants, on page 17, lines 13-15, disclose PVP, CMC and hyaluronic acid. On page 18, line 16 PEG and copolymers of PEG and dimethylmethacrylate are specified. Applicants, in the examples demonstrate utility for PVP, CMC, and hyaluronic acid. There is no showing for any polypeptide. However, applicants claim any polysaccharide, any synthetic polymer and any polypeptide. Thus, the specification is insufficient to support the breadth of the claims.

Claims 1-14 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to that which is disclosed. See M.P.E.P. §§ 706.03(n) and 706.03(z).

On page 19, line 1, applicants disclose polyelectrolyte polysaccharides. No others are disclosed.

However, applicants claim all polysaccharides, thus, the specification is insufficient to support the breadth of the claims.

Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5,080,893. Although the conflicting claims are

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not identical, they are not patentably distinct from each other because the inventing concept of the instant claims are generic to 5,080,893.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Webman whose telephone number is (703) 308-4432.

*ejw*  
EDWARD J. WEBMAN  
PRIMARY EXAMINER  
GROUP 1500

Edward J. Webman:cb  
June 9, 1994  
June 14, 1994